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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/927,050	08/09/2001	Ryosuke Takeuchi	450100-03410	4114

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NEW YORK, NY 10151

EXAMINER

TRAN, HENRY N

ART UNIT	PAPER NUMBER
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2629

MAIL DATE	DELIVERY MODE
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11/30/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.		Applicant(s)	
	09/927,050		TAKEUCHI, RYOSUKE	
	Examiner		Art Unit	
	Henry N. Tran		2629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 October 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 5-15 and 17-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5-15 and 17-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 August 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/4/07 has been entered. Claims 1-3, 5-15 and 17-34 remain pending in this application. The examination results are as follows.

Response to Arguments

2. Applicant's amendments to the claims have overcome the rejections under 35 U.S.C. 112(2) recited in items 4 and 5 of the Office action mailed 7/31/07.

3. Applicant's arguments submitted in pages 13-16 of the amendment filed 10/4/07 with respect to the rejections of claims under 35 USC 103(a) have been fully considered but they are not persuasive because of the following reasons:

Applicant argued that the combination of the prior art, the U.S. Patents Nos.: 6,332,024 (Inoue) and 6,128,012 (Seidensticker), does not teach or suggest the claimed invention that requires a display unit configured to display a plurality of lists in hierarchy and to eliminate a mark indicating a direction if the pointer can not be shifted to another list in a different list of hierarchy. The Examiner respectfully disagrees because Inoue does teach a display unit 2 configured to display a plurality of lists in hierarchy, see Figs. 5A-D; Seidensticker does teach a display unit 34 configured to display a list of menu, a pointer (a bold indication) and arrowhead

marks 132 and 134, wherein, a mark is eliminated when the mark indicating a direction if the pointer can not be shifted to another list. Clearly, an ordinary skilled artisan would be motivated to combine the teachings of Inoue and Seidensticker for producing the claimed invention. Claims 1-3, 5-15 and 17-34 are therefore rejected; and the rejections are set forth below.

Drawings

4. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the: “a plurality of lists in a hierarchy” and “a different lair of the hierarchy” (independent claims 1, 11, 12 and 14) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will

be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-3, 5, 6, 9-15, 17-25 and 28-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,332,024 (“Inoue”) in view of U.S. Patent No. 6,128,012 (“Seidensticker”).

Regarding claims 1 and 12, Inoue, Fig. 1, teaches a portable communication apparatus (1) comprising: a display unit (2) configured to display a plurality of lists in hierarchy (Inoue Fig. 5C illustrates a LCD display unit 2 configured to display a list in a directory mode B2; the list comprises a plurality of lists of registered names and types of telephones, and a lower hierarchy comprising information of one of the list illustrated in Fig. 5D; wherein, each list is a display of the highest levels of dictionary structure, thereby enabling the user to select a specific directory and subdirectory in the hierarchy for accessing desired data); a pointer (CB2) specifying one portion of information of one of the list, see Fig. 5C; a user operation unit (3, 4A and 4B) and its associated markers, i.e., icons (Up/Down Arrows, Left Arrow, and Right Arrow: IB10, IB11, and IB12); and a controller (CPU 10) configured to shift said pointer to a desired position in accordance with an operation of said operation unit, see also, Fig. 5B, and col. 8, line 47 to col. col. 9, line 38.

However, Inoue does not teach that the controller is configured to: (i) “eliminate said mark indicating a direction if said pointer can not be shifted to another list in a different lair of the hierarchy” (claim 1), or (ii) “eliminate said mark from the display unit if another list does not exist at the next position of said portion of information of a different lair of hierarchy specified by said pointer in the direction which said mark indicates”

Seidensticker teaches a portable communication apparatus (30) comprising a display unit (34) configured to display a hierarchy comprising a list of menu or menus with different menu level, a pointer (a bold indication) and arrowhead marks 132 and 134, an operation unit (36), and a controller (CPU 50), which is configured to implement a function to select an information item listed in a hierarchy on the display unit, and to eliminate a mark indicating a direction if said pointer can not be shifted to another list in the direction from the currently displayed list, for example, Seidensticker, Figs. 1, 2, 6A and 6B, teaches a controller (CPU 50) configured to implement a function to select an information item displayed in a hierarchy comprising a list of a plurality of menu items on the display unit 34, and to eliminate a mark (134), which indicates the upper direction (an upwardly pointing arrowhead), from the display unit if the pointer, e.g., bold font indication 130, can not be shifted to another list (another item) in the desired upper direction from the currently displayed item, which is “**BLACKJACK**”, because it is the first item listed at the top, and other item does not exist at the next upper position), see col. 11, line 29 to col. 12, line 19.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to implement the function of eliminating a mark as taught by Seidensticker in the Inoue system because this would provide an improved user interface capable of enhancing the functionality

and reliability of the control, selection, and viewing data items displayed on a screen, see Seidensticker, Jr., col. 1, lines 12-18. By said rationale, claims 1 and 12 are rejected.

Regarding claims 2, 3, 5, 6, 9 and 10, Inoue further teaches that the operation unit (3, 4A, and 4B) is a dial and/or a push key, see col. 5, lines 10-15. Seidensticker does teach that the mark 132 indicating a lower direction or the mark 134 indicating an upper direction is eliminated from the display when the list or item in the lower direction of the last item, or when the list or item in the upper direction of the first item is not displayed or existed, see Figs. 6A, 6B, and 7; and col. 11, line 55 to col. 12, line 48. Claims 2, 3, 5, 6, 9 and 10 are dependent upon the base claim 1, and are therefore rejected on the same reasons set forth in claim 1, and by the reasons noted above.

Regarding claims 13 and 30-34, which depend upon the base claim 12, and comprises similar claimed elements and limitations of claims 1, 2, 3, 5, 6, 9 and 10, and are therefore rejected on the same basis set forth in claims 1, 2, 3, 5, 6, 9, 10, and 12 discussed above.

Regarding claims 11, 14, 15, 17-25, 28, and 29, which are method claims corresponding to the apparatus claims 1-3, 5, 6, 9, 10, 12, 13, and 30-34, and are therefore rejected on the same basis set forth in claims 1-3, 5, 6, 9, 10, 12, 13, and 30-34 discussed above.

7. Claims 7, 8, 26, and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Inoue in view of Seidensticker (hereinafter referred to as "Inoue-Seidensticker") as applied to claims 1 and/or 11 above, and further in view of Yankowski (U.S. Patent No. 6,388,958).

Inoue-Seidensticker, Jr. teaches generally all as discussed above. Inoue further teaches that the controller CPU 10 is configured to reproduce audio data, see figure 2, and col. 6, lines 4-

12. However, Inoue-Seidensticker does not teach said portion of information is a title of a song, and an editing unit configured to edit the order of said portions of information on said display unit.

Yankowski teaches a computer system comprising a display/control unit (82), a memory (72), and a controller (68), which are configured to display information, which is a play list of titles of songs, whose orders can be manipulated, deleted, or rearranged, see col. 10, line 55 to col. 11, line 3.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the editing function as taught by Yankowski in the Inoue-Seidensticker, Jr. system because this would an improved user interface capable of enhancing the selection and playing of the song play list displayed on a screen.

By this rationale, claims 7, 8, 26, and 27 are rejected.

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Henry N. Tran whose telephone number is 571-272-7760. The examiner can normally be reached on M-F 8:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bipin H. Shalwala can be reached on 571-272-7681. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Henry Tran/
Henry N Tran
Primary Examiner
Art Unit 2629

HT
11/26/07